

Appl. No. 10/811,671  
Atty. Docket No. 8768MD  
Amdt. dated April 27, 2005  
Reply to Office Action of January 27, 2005  
Customer No. 27752

### REMARKS

#### Claim Status

Claims 1 – 27 are pending in the present application. Claims 1-10, 15-17 and 23-27 stand rejected. Claims 11-14 and 18-22 stand objected to but have been indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1 has been amended to recite the subject matter of the present invention in a clearer manner. In particular, Claim 1 now includes the additional language of “substrate and wherein said elastic component is thereby formed and joined to the first substrate in a single step continuous process.” Claims 13 and 24 have both been amended to correct typographical errors. Support for this amendment is found at page 7, lines 22-25. Claim 13 includes an “a” that was changed to an “an” while Claim 24 includes a “composite” that was corrected to “article” as is found in the base claim. No additional claims fee is believed to be due.

#### Rejection Under 35 USC §102(b) Over Newkirk et al (US Patent 5921973)

Claims 1, 5-7, 10, 15-17, and 23-27 are rejected under 35 USC §102(b) as being anticipated by Newkirk et al (US Patent 5921973). The Office states that Newkirk discloses an absorbent article comprising an elastic component comprising a first substrate 11 having an elastomeric composition 13 (col. 5, lines 55-63) disposed there in a predetermined geometric pattern (col. 5, lines 39-55), such that the elastomeric composition partially penetrates the first substrate. Specifically, the Office cites various passages in the patent to tie in their relevant disclosure versus claims 5, 6, 10, 15-17, and 23-26. Applicant respectfully traverses this rejection.

Applicant submits that each of the rejected claims are, in fact, novel and therefore unanticipated by Newkirk. This reference discloses a composite elastic nonwoven fabric that includes a layer of inelastic continuous or staple fibers formed from a blend of polyethylene and polypropylene laminated to an elastic layer. Preferably, the composition of the fibers ranges between 5 to 50 percent by weight of the polypropylene with the balance made up of polyethylene. The nonelastic fibers are capable of being highly elongated upon mechanical stretching without adversely impacting fiber tie down. Now, despite the fairly specific disclosures of Newkirk, there is still no teaching or suggestion therein of an elastomeric component comprising an elastomeric composition that partially penetrates a first substrate as is required in Applicant's claims. Such a result is not taught by Newkirk because it is not a characteristic of the manufactured fabric

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which is disclosed. Thus, there simply cannot be anticipation of the present invention on this missing element.

Furthermore, it is important to note that Applicant appreciates the subject matter that is well known to one skilled in the art. In fact, the fabric and method of making the fabric of Newkirk is contrasted with the present invention at page 7, lines 19-25 of the present specification. There, Applicant describes clearly an important distinction between what is known as conventional elastic fabric manufacturing (i.e., Newkirk and similar references) and Applicant's invention. In particular, the specification reads that the present invention "provides a novel process that combines the step of making of [sic] an elastomeric component and the step of joining the elastomeric component to a substrate into a single step process. Accordingly, Applicant has amended Claim 1 to reflect this distinction between the art and the present invention by referring to this simplified processing. On the other hand, Newkirk and other skilled artisans have taught joining the "discrete pieces of elastomeric materials to the substrate using known bonding methods....". This distinction in teaching is made evident further by Newkirk at col. 5, lines 39-44 wherein the patentee discloses that "the composite fabric 10 is formed by laminating nonelastic layer 11 and elastic layer 12 utilizing any of the well established thermal or chemical techniques including thermal point bonding, through air bonding, and adhesive bonding, with adhesive bonding being preferred." Newkirk therefore does not teach or suggest Applicant's single step formation of the elastic/elastomeric component. Rather, Newkirk teaches away from this process. Clearly, there can be no anticipation present where a teaching away exists.

For these reasons, Applicant submits that the rejection of these claims is improper over Newkirk under 35 USC §102(b) as anticipated. Accordingly, Applicant requests reconsideration and withdrawal of these rejections.

#### Rejection Under 35 USC §103(a) Over Newkirk

Claims 2-4, 8, and 9 stand rejected under 35 USC §103(a) as being unpatentable over the same Newkirk reference. The Office reasons that with regard to Claims 2-4, the reference discloses the claimed invention except for the elasticity and therefore relies on Newkirk as teaching that the elasticity can be varied depending on the fiber composition of the composite. Similarly, the Office believes that as to Claims 8 and 9, Newkirk discloses the claimed invention except for the reference's failure to disclose the dimensions of the adhesive elements. As a result, the Office reasons that Newkirk discloses adhesive bonding in a predetermined pattern that is suitable to allow the

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composite to be flexible and extensible and consequently the general conditions of the claim are disclosed. Applicant traverses these rejections for the same reasons as detailed above. First, the reference (summarized earlier) does not teach or suggest Applicant's claimed elastomeric component element that partially penetrates a first substrate. Second, the reference does not teach or suggest Applicant's elastomeric component that is formed in a single step continuous process. In fact, Newkirk teaches away from this element. In such cases, it is well settled that obviousness cannot be established by a combination of references where one of the references teaches away from the claimed invention. In re Grasselli, 281 USPQ 769, 780 (Fed. Cir. 1983). Surely, a teaching away cannot be found when the single reference cited teaches away from the invention. Consequently, Applicant once again asserts that this rejection under §103(a) is improper.

#### Conclusion

In light of the above remarks, it is requested that the Office reconsider and withdraw the rejections under both 35 USC §§102(b) and 103(a) of the claims of this application. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-27 is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By 

Dara M. Kendall  
Registration No. 43,709  
(513) 634-1787

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Customer No. 27752